

PTO/SB/33 (07-05)

United States Patent &amp; Trademark Office; U.S. DEPARTMENT OF COMMERCE

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>	Docket Number (Optional) 59558.00018
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed Name _____	Application Number:  10/633,691  Filed: August 5, 2003  First Named Inventor:  Kiyoji MINEGISHI, et al.  Art Unit: 3726  Examiner: David P. Bryant

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal and Petition for Two Month Extension of Time.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.  
☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under  
37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.  
Registration No. 51,091

☐ Attorney or agent acting under 37 CFR 1.34.  
Reg. No. is acting under 37 CFR 1.34 \_\_\_\_\_

  
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February 13, 2006  
\_\_\_\_\_  
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.



## PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kiyoji MINEGISHI, et al.

Art Unit: 3726

Application No.: 10/633,691

Examiner: Bryant, David P.

Filed: August 5, 2003

Attorney Dkt. No.: 59558.00018

For: METHOD FOR ASSEMBLING ROTOR AND SLIDING STRUCTURE OF ROTOR AND OSCILLATOR

### **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

February 13, 2006

This is a Pre-Appeal Brief Request for Review from the final rejection set forth in an Office Action dated August 8, 2005 ("Office Action"), finally rejecting claims 1-3 and 6. Applicants submit that cited reference fails to disclose or suggest all of the limitations of any of the pending claims and that there is clear error with regard to at least one element of each of the independent claims.

#### **The cited reference fails to disclose or suggest all of the limitations of pending claims**

The claim rejections are set forth in page 2 of the Office Action. The Office Action rejected claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Application JP 2000-179544 (JP '544). The Office Action took the position that JP '544 disclosed all of the features recited in claim 1. Claim 1 is a method claims that recites in part the feature of loading a plurality of rolling elements to be arranged between said rotor and said oscillator via a retainer for

positioning said rolling elements from inside said retainer, and assembling said rotor inside said loaded rolling elements.

Instead, JP '544 discloses how the rollers 74 are inserted only in paragraph [0003], with reference to Figure 7. Please note that paragraph [0003] and Figure 7 relate to the Prior Art of JP '544. Paragraph [0003] states that rollers 74 are conventionally inserted from the outside of the retainer 70, while deforming the retainer 70. Further, the size of each stopper 76 of packets 75 is smaller than an outer diameter of each roller 74. Figure 1 of JP '544 illustrates the same as Figure 7.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be discussed below, JP '544 fails to expressly or inherently disclose each and every element of the invention.

Applicants respectfully submit that because it cannot be determined how the rollers are inserted in JP '544, JP '544 cannot be interpreted as disclosing that the rollers are inserted from the inside of the retainers, as recited in claim 1. As discussed above, the description of JP '544 does not expressly or implicitly state that the rollers 74 are inserted from inside the retainers 70. Further, any assertion that this feature is inherent is not supported in either the specification, or any of Figures 1, 6 and 7, as alleged in the Office Action. Thus, Applicants respectfully submit that each element of claim 1 is not either expressly or inherently disclosed in JP '544.

Further, since the rollers 74 are inserted into pockets 75 of the retainer 70 as the retainer 70 changes shape, Applicants respectfully submit that it can not possibly be determined how to insert

the rollers, based on the size of the rolling elements. Therefore, Applicants respectfully submit that because it cannot be determined in JP '544 how the rollers 74 are inserted into the retainers 70, JP '544 fails to disclose or suggest the feature that the rollers are inserted from the inside of the retainers, as recited in claim 1. JP '544 cannot properly be interpreted, therefore, as an enabling reference under 35 U.S.C. section 102.

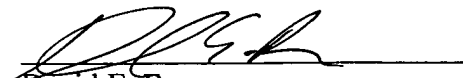
In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure' . . . . In re Hoeksema, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipated reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. Elan Pharm. Inc. v. Mayo Foundation for Medical and Education Research, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003).

Thus, the Office Action is in clear error in asserting that JP '544 explicitly discloses that the rollers are inserted from the inside of the retainers.

## Conclusion

For all of the above noted reasons, it is respectfully requested that the pending anticipation rejections be withdrawn, because the reference does not teach or suggest all of the elements of any of the presently pending claims. Hence the lack of a *prima facie* case of anticipation constitutes clear error as a basis for rejecting the presently pending claims. Therefore, it is respectfully requested that all of the pending claims be allowed, and that this application be passed to issue.

Respectfully submitted,

  
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Enclosures: Form PTO/SB/33  
Notice of Appeal